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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dara Ung

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05/21/2004

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EXAMINER

PEACHES, RANDY

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,363

Applicant(s)

UNG ET AL.

Examiner

Randy Peaches

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/05-20-2003</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. ***Claims 1-16, 20-25, 29-31*** are rejected under 35 U.S.C. 102(e) as being unpatentable by Mcdowell et al (U.S. Publication 2001/0034224 A1).

Regarding ***claims 1 and 7***, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed “short message service center (SMSC)”, a home location register (HLR), which reads on claimed “module”, for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed “service provider”, including said SMSC, a message handler comprising:

- a registration notification message (REGNOT) and MSINACT, which reads on claimed “MSInactivity”, receiver to alert other wireless users of a said user’s presence (see paragraph [0032]). **In addition, Mcdowell discloses in paragraph [0046], that REGNOT/MSINACT receiver is a Message Event**

Sever (MES) capable of receiving and processing the user event information (e.g. network information relating to the presence and/or location of a said wireless user (see paragraph [0044, 0045]) received over a TCP/IP connection from a said HLR and further producing an associated presence and/or location; and

- a registration notification message (REGNOT) and MSINACT, which reads on claimed "MSInactivity", forwarder to forward a said (REGNOT) and MSINACT received by a Mobile Switch Center (MSC) over an internet connection. See paragraph [0033, 0046].

Regarding **claims 2 and 8**, according to **claims 1 and 7**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed "short message service center (SMSC)", a home location register (HLR), which reads on claimed "module", for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed "chat session participant", by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed "service provider", including said SMSC, a message handler wherein:

- Mcdowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 3 and 9**, according to **claims 1 and 7**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed “short message service center (SMSC)”, a home location register (HLR), which reads on claimed “module”, for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed “service provider”, including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) forwarder replicates, which reads on claimed “copies”, all said REGNOT and MSINACT received by said MSC. See paragraphs [0044, 0045, 0046].

Regarding **claims 4 and 10**, according to **claims 1 and 7**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed “short message service center (SMSC)”, a home location register (HLR), which reads on claimed “module”, for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed “service provider”, including said SMSC, a message handler wherein:

- a gateway, which reads on claimed “wireless internet gateway”, to transmit said forwarded notification messages (user event information) over said Internet connection. See FIGURE 1 paragraphs [0033, 0035, 0037, 0039, 0041].

Regarding **claims 5 and 11**, according to **claims 4 and 10**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed “short message service center (SMSC)”, a home location register (HLR), which reads on claimed “module”, for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed “service provider”, including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) handler communicates with the said gateway, which reads on claimed “wireless internet gateway”, using signaling system #7 (SS7) communication protocol. See paragraphs [0033, 0037, 0039, 0041, 0047].

Regarding **claims 6 and 12**, according to **claims 1 and 7**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in paragraph [0039], a short message service (SMS) server, which reads on claimed “short message service center (SMSC)”, a home location register (HLR), which reads on claimed “module”, for permitting automatic status tracking of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc.,

which reads on claimed “chat session participant”, by an application external to a cellular/PCS network (see FIGURE 1 paragraph [0035]), which reads on claimed “service provider”, including said SMSC, a message handler wherein:

- said registration notification message (REGNOT) and MSINACT (user event information) is previously forwarded by a said HLR. See FIGURE 10a paragraphs [0029, 0032, 0039].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. ***Claims 13-16, 20-25, and 29-31*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mcdowell et al (U.S. Publication 2001/0034224 A1).

Regarding ***claims 13 and 22***, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, comprising:

- receiving an IS-41 conforming registration notification message (REGNOT), as taught by Mcdowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user's device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming registration notification message (REGNOT) over an internet connection, see paragraph [0033], to a said Short Message Service Center (SMSC), which reads on claimed "external chat server". Mcdowell et al teaches of this occurrence in paragraph [0046].

However, Mcdowell et al does not clearly render evidence that the receiving of the said IS-41 conforming message from a said MSC is over a TCP/IP connection.

Consequently, McDowell does teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such TCP/IP for example.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Mcdowell et al (U.S. Publication 2001/0034224 A1) to include a TCP/IP link capable of allowing the said information to traverse from a MSC to a message handler. In doing so, this in fact, would not render the claimed invention patentable over McDowell et al.

Regarding **claims 14 and 23**, according to **claims 13 and 22**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039,

0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, wherein:

- said registration notification message is a REGNOT message. See paragraph [0046]. Examiner further concludes, as evident in FIGURE 10a, the HLR is receiving the said notification message from the said MSC over a said Internet connection.

Regarding **claims 15 and 24**, according to **claims 13 and 22**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, wherein:

- Mcdowell et al teaches in paragraph [0035], that the said Internet connection utilizes a TCP/IP protocol.

Regarding **claims 16 and 25**, according to **claims 13 and 22**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039,

0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, wherein:

- Mcdowell et al teaches in paragraphs [0035, 0039, 0040], said registration notification message is additionally forwarded by a said SMSC.

Regarding **claims 20 and 29**, according to **claims 13 and 22**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, wherein:

- said registration notification message is signaling system #7 (SS7) and IS-41 compliant. See paragraph [0046, 0054].

Regarding **claims 21 and 30**, according to **claims 13 and 22**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method and system, which reads on claimed “apparatus”, for automatically notifying an external message distribution system, commonly referred to

as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, wherein:

- said registration notification message is IS-41 compliant. See paragraph [0046, 0054].

Regarding **claim 31**, Mcdowell et al (U.S. Publication 2001/0034224 A1) discloses in FIGURE 10a and 10b paragraphs [0039, 0046, 0057, 0058], of a method for automatically notifying an external message distribution system, commonly referred to as a Short Message Service Center (SMSC), which reads on claimed “external chat server”, of the presence of a wireless user e.g. wireless telephone, PDA, a pager, a vehicle, etc., which reads on claimed “chat session participant”, comprising:

- receiving an IS-41 conforming MSINACT, which reads on claimed “MSInactivity notification”, as taught by Mcdowell et al when an event trigger is initiated in paragraphs [0046, 0056, 0057, 0058], e.g. when a said user’s device is turned on, from a Mobile Switching Center (MSC); and
- automatically forwarding, see FIGURE 10a paragraphs [0032], the said IS-41 conforming MSINACT, which reads on claimed “MSInactivity notification”, over an internet connection, see paragraph [0033], to a said Short Message Service Center (SMSC), which reads on claimed “external chat server”. Mcdowell et al teaches of this occurrence in paragraph [0046].

However, Mcdowell et al does not clearly render evidence that the receiving of the said IS-41 conforming message from a said MSC is over a TCP/IP connection.

Consequently, McDowell does teach in paragraph [0046], that the transmission of information may be conducted over a variety of communication links, such TCP/IP for example.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Mcdowell et al (U.S. Publication 2001/0034224 A1) to include a TCP/IP link capable of allowing the said information to traverse from a MSC to a message handler. In doing so, this in fact, would not render the claimed invention patentable over McDowell et al.

3. **Claims 17-19, 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mcdowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2).

Regarding **claims 17 and 26**, according to **claims 13 and 22**, McDowell et al fails to disclose of adding a user corresponding to the forwarded registration notification message to a chat session.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to

a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session".

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify McDowell et al (U.S. Publication 2001/0034224 A1) to include Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus where a user corresponding to a forwarded notification message can be automatically added to a chat session.

Regarding **claims 18 and 27**, according to **claims 17 and 26**, McDowell fails to disclose of automatically notifying other chat participants of the presence of the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, of automatically adding a user of a mobile station corresponding to a said forwarded notification that the said user is "on-line", which in turn, adds the user to a list of individuals whose status of communication is of relevance to the said user (see column 3 lines 1-10), which reads on claim "chat session". Additionally, as stated in column 3 lines 56-66, that an action is preformed in order to notify other chat participants, which reads on claimed "chat participants", who are of the same status as the added user that the user is available for communication.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of McDowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2) in order to achieve

a method and apparatus which automatically notifies other chat participants regarding the presence of a an automatically added said user.

Regarding **claims 19 and 28**, according to **claims 17 and 26**, McDowell fails to disclose of an external server automatically sending a list of chat participants to the added user.

Sandegren (U.S. Patent 6,512,930 B2) teaches in column 5 and 6 lines 46-67 lines 1-17 respectively, that the server or Wireless On-line Notification (WOLN) server sends a list of "on-line" users, which reads on claimed "chat participants", to a said user of interest.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Mcdowell et al (U.S. Publication 2001/0034224 A1) in view of Sandegren (U.S. Patent 6,512,930 B2) in order to achieve a method and apparatus which automatically sends a list of chat participant to a user of interest to established communications with the list chat participants if the user so desires.

Response to Arguments

Applicant's arguments filed March 23, 2004 have been fully considered but they are not persuasive.

Per the applicant's statements justifying the fact that Mcdowell's Provisional Application Filing date of January 26, 2001 cannot be relied upon as prior art is due to

the degree of the disclosure is unknown to the applicant, stands fully over-come. **Since the patent application (U.S. Publication 2001/0034224 A1) claims priority to the Provisional Application Number 06/178,142, filed on January 26, 2000, it is determined that McDowell et al has privilege to the earlier Provisional filing date, which is January 26, 2000.**

Regarding ***claims 1-31***, after further examination, the Examiner respectfully concludes that the Applicant's arguments are not persuasive.

The Applicant argues on pages 10-11 that registration notification and MSInactivity messages are received over a TCP/IP connection, which McDowell et al does not render. **The Examiner concludes that McDowell et al do indeed discloses in paragraph [0046], that REGNOT/MSINACT receiver is a Message Event Sever (MES) capable of receiving and processing the user event information (e.g. network information relating to the presence and/or location of a said wireless user (see paragraph [0044, 0045]) received over a "TCP/IP" connection from a said HLR and further producing an associated presence and/or location.**

In addition, the Applicant argues on page 11 that Sandegren discloses that all of the messages within the system are sent to components within the wireless system.

Sandegren, as referenced in this and prior Office Action, is used as the secondary reference in conjunction with the primary reference McDowell et al. Therefore, although Sandegren does not expressly teach of the above argument, McDowell et al does teach of parsing messages outside of the wireless system

over a TCP/IP connection. The Examiner concludes that it would have been obvious to combine the primary teachings of McDowell et al with the secondary teaching of Sandegren to develop a method and apparatus capable of parsing messages, outside of a wireless system, to a first user to notify of the presence of other users in a mobile communication system specifically over a TCP/IP connection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. **U.S. Patent 6,317,594 B1** - *A System and Method for Providing Data to a Wireless Device Upon Detection of Activity of a Device on a Wireless Network*
- b. **U.S. Patent 6,397,054 B1** - *Features for Emergency Calling and Short Messaging System*
- c. **U.S. Patent 6,208,870 B1** - *Short Message Service Notification Forwarded Between Multiple Short Message Service Centers*
- d. **U.S. Patent 6,370,373 B1** - *System and Method for Detecting Cloning Fraud in Cellular/PCS Communications*

**e. U.S. Patent 6,505,046 B1 – Method and Apparatus for Distributing Location-Based
Messages in a Wireless Communication Network**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-5576.

Randy Peaches

May 3, 2004


NAY MAUNG
SUPERVISORY PATENT EXAMINER